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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/539,888	12/12/2005	Johannes Kalhoff	2133.095USU	1974

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OHLANDT, GREELEY, RUGGIERO & PERLE, LLP  
ONE LANDMARK SQUARE, 10TH FLOOR  
STAMFORD, CT 06901

EXAMINER
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JARRETT, RYAN A

ART UNIT	PAPER NUMBER
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2121

MAIL DATE	DELIVERY MODE
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10/17/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/539,888	<b>Applicant(s)</b> KALHOFF ET AL.	
	<b>Examiner</b> RYAN A. JARRETT	<b>Art Unit</b> 2121	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 02 September 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-16 and 19-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 and 19-31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

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## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 09/02/08 has been entered.

### ***Priority***

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

***Response to Arguments***

Applicant's arguments filed 09/02/08 have been fully considered but they are not persuasive. Applicant argues that Cromer et al.'s "RFID tag...does not appear to hold information pertaining to an installation location in a system", as recited in claim 1. However, Examiner asserts that the RFID tag of Cromer et al. holds MAC address data (e.g., col. 3 lines 38-39), which corresponds to the claimed information "pertaining to an installation location". This interpretation is consistent with Applicant's own specification, which discloses that the information pertaining to an installation location can be address data (e.g., pg. 4 lines 12-16).

Applicant also argues that Cromer et al.'s "RFID tag is situated in the computer", in an apparent attempt to support the aforementioned argument that Cromer et al.'s "RFID tag...does not appear to hold information pertaining to an installation location in a system". However, even if it were true that "Cromer et al.'s "RFID tag is situated in the computer" (which examiner does not necessarily concede to be the case), it is not clear what significance or relation this purported fact has to the actual claim language, since the claim language does not appear to preclude an embodiment of an RFID tag situated in a computer.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-16 and 19-31 are rejected under 35 U.S.C. 102(b) as being anticipated by Cromer et al. US 6,177,860. Cromer et al. discloses:

**Regarding claims 1, 8, 26 and 27**

Cromer teaches a method, an apparatus, or a system "comprising: situating a configuration device at an installation location in a system, wherein the configuration device is connected to a coupler for an intelligent unit" (e.g. col. 3 lines 44-65 and col. 4 lines 17-22, the computer can adapt to a customer location by sending RFID tag information to a host); "and storing data in the configuration device, pertaining to the installation location, wherein the data is transmitted from the configuration device to a logic device that processes the data for configuration of the intelligent unit" (e.g. col. 5 lines 11 -46).

**Regarding claim 2**

Cromer teaches "the method as claimed in claim 1, further comprising the following steps: provisioning the intelligent unit with the logic device" (e.g. col. 4 in particularly lines 17-22); "coupling the intelligent unit to the coupler" (e.g. col. 4 lines 4-10); "connecting the intelligent unit to the configuration device" (e.g. FIG. 4); "and transmitting the data from the configuration device to the logic device" (e.g. col. 3 lines 44-49).

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**Regarding claim 3**

Cromer teaches "the method as claimed in claim 1, further comprising: transmitting data from the intelligent unit to the configuration device and storing the data from the intelligent unit in the configuration device" (e.g. col. 4 lines 23-32).

**Regarding claim 4**

Cromer teaches "the method as claimed in claim 1, further comprising matching data between the intelligent unit and the configuration device" (e.g. col. 3 lines 30-43).

**Regarding claim 5**

Cromer teaches "The method as claimed in claim 1, wherein the intelligent unit is in a network" (e.g. FIG. 2).

**Regarding claim 6**

Cromer teaches "The method as claimed in claim 1, wherein the storing and/or the transmitting of the data is carried out as a single step, or as a repeatable step" (e.g. col. 3 lines 56-65).

**Regarding claim 7**

Cromer teaches "The method as claimed in claim 1, wherein the storing and/or the-transmitting of the data performed securely" (e.g. col. 4 lines 1 - 16).

**Regarding claim 9**

Cromer teaches "The apparatus as claimed in claim 8, comprising: an intelligent unit with an associated logic device for processing data for configuration of the intelligent unit" (e.g. col. 3 lines 57-65); "and a configuration device which is associated with a defined application and/or a defined location" (e.g. col. 3 lines 30-43), "and is permanently or detachably connected to the coupler" (e.g. col. 3 lines 1-3), "for storage of application-based

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and/or location-based configuration data and/or behavior description data" (e.g. col. 3 lines 56-65), "wherein the intelligent unit and the configuration device can be connected to one another in such a way that data can be transmitted at least from the configuration device to the logic device for adaptation of the intelligent unit to the application and/or the location" (e.g. col. 4 lines 1-16).

#### **Regarding claim 10**

Cromer teaches "The apparatus as claimed in claim 8, comprising: a configuration device, which can be associated with a defined application and/or a defined location of an intelligent unit and can be permanently or detachably connected to the coupler" (e.g. col. 3 lines 1-3 and lines 30-43), "for storage of application-based and/or location-based configuration data and/or behavior description data" (e.g. col. 3 lines 56-65), "wherein the configuration device can be connected to a logic device for processing of data for configuration of an intelligent unit in such a way that data can be transmitted at least from the configuration device to the logic device" (e.g. col. 4 lines 1-16).

#### **Regarding claim 11**

Cromer teaches "The apparatus as claimed in claim 8, comprising: an intelligent unit with an associated logic device for processing of data for configuration of the intelligent unit" (e.g. col. 3 lines 57-65), "wherein the intelligent unit can be connected to a configuration device, which is associated with a defined application and/or a defined location of the intelligent unit and is permanently or detachably connected to the coupler" (e.g. col. 3 lines 1-3 and lines 30-43), for storage of application-based and/or location-based configuration data and/or behavior description data" (e.g. col. 3 lines 56-65), "in such a way that data can be transmitted at least from the configuration device to the logic device for adaptation of the

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intelligent unit to the application and/or the location" (e.g. col. 4 lines 1-16).

**Regarding claim 12**

Cromer teaches "The apparatus as claimed in claim 8, further comprising: the intelligent unit being within a network" (e.g. FIG. 2).

**Regarding claim 13**

Cromer teaches "The apparatus as claimed in claim 8, further comprising: the intelligent unit having a system component" (e.g. FIG. 2).

**Regarding claim 14**

Cromer teaches "The apparatus as claimed in claim 8, further comprising: the application-based and/or location-based data comprising an address, a component identification, configuration data and/or data for configuration" (e.g. col. 4 lines 1-16).

**Regarding claim 15**

Cromer teaches "The apparatus as claimed in claim 8, further comprising: the logic device which is associated with the intelligent unit being designed for data transmission to the configuration device" (e.g. col. 3 lines 44-49).

**Regarding claim 16**

Cromer teaches "The apparatus as claimed in claim 8, further comprising: the configuration device being designed to receive and store data from the logic device which is associated with the intelligent unit" (e.g. col. 5 lines 37-50).

**Regarding claim 19**

Cromer teaches "The apparatus as claimed in claim 8, further comprising: the configuration



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device being associated with a connecting device, which is arranged at the coupler, for connection of the intelligent unit" (e.g. col. 2 line 57 to col. 3 line 3).

**Regarding claim 20**

Cromer teaches "The apparatus as claimed in claim 8, further comprising: the configuration device being designed for storage, reading and/or processing of further data" (e.g. col. 4 lines 1-16).

**Regarding claim 21**

Cromer teaches "The apparatus as claimed in claim 8, further comprising: the data of the configuration device being variable, readable and/or processable by remote control and/or externally" (e.g. col. 5 lines 37-46).

**Regarding claim 22**

Cromer teaches "The apparatus as claimed in claim 8, further comprising: the configuration device and the intelligent unit having complementary means for provision of a unidirectional and/or bidirectional data transmission connection, in particular using screw-in and/or plug-in connectors, a contact-based , optical and/or a radio connection" (e.g. col. 3 lines 56-65).

**Regarding claim 23**

Cromer teaches "The apparatus as claimed in claim 8, further comprising: the configuration device being designed as equipment for an automation system" (e.g. FIG. 2 and col. 4 lines 1-16).

**Regarding claim 24**

Cromer teaches "The apparatus as claimed claim 8, further comprising: the configuration device and/or the logic device having hardware and/or software elements" (e.g. col. 3 lines 11-30).

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**Regarding claim 25**

Cromer teaches "The apparatus as claimed in claim 8, further comprising: the logic device which is associated with the configuration device being part of the configuration device or part of a further device which can be connected to the configuration device, in particular a central control device" (e.g. col. 3 lines 56-65).

**Regarding claim 28**

Cromer teaches "The system as claimed in claim 27, wherein the system is adapted for operation of an automation system" (e.g. col. 2 lines 10- 19).

**Regarding claim 29**

Cromer teaches "The apparatus of claim 8, wherein the configuration device is part of a permanent wiring to which the intelligent unit can be coupled (e.g. col. 3 lines 50-55).

**Regarding claim 30**

Cromer teaches "The method of claim 1, wherein said installation location coincides with an application location" (e.g. col. 3 lines 56-65).

**Regarding claim 31**

Cromer teaches "The method of claim 1, wherein said data is selected from the group consisting of application-based configuration data, location-based configuration data, behavior description data, and a combination thereof (e.g. col. 3 lines 30-39).

***Conclusion***

All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.114. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). For guidance and precedent on this issue of “same invention”, see petition decision mailed 08/01/08 in Application No. 10/999,727.

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to RYAN A. JARRETT whose telephone number is (571)272-3742. The examiner can normally be reached on 10:00-6:30 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Albert Decady can be reached on (571) 272-3819. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Ryan A. Jarrett/  
Primary Examiner, Art Unit 2121

10/09/08